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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,550	08/27/2001	Ai Yano	1405.1047	1740
21171	7590	06/16/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			BARQADLE, YASIN M	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/938,550	<b>Applicant(s)</b> YANO ET AL.	
	<b>Examiner</b> Yasin M. Barqadle	<b>Art Unit</b> 2153	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-14 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

**Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 19, 2006 has been entered.

**Response to Amendment**

2. The amendment filed on April 19, 2006 has been fully considered but are not persuasive.

- Claims 1-5 and 7-14 are presented for examination.

**Response to Arguments**

3. As to Applicant's argument that Tornabene "neither teaches nor suggests highlighted file name extraction means for extracting file names that can be registered as highlighted files from chat character strings inputted by a user within a

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channel" or 'highlighted file resgistration determination means for determining whether or not a file corresponding to an extracted file name is to be registered as a highlighted file" (page 13 of the remarks). Examiner notes that Tornabene et teach selecting screen name of member to be invited to register for alerts by using mouse clicking (§ 0080-0085), and also notifying said server of registration information for said highlighted file "In one implementation, the current member 702a presents a user interface to a subscriber for inputting a screen name or e-mail address associated with the prospective member 702b. In another implementation, the current member 702a sends an invitation when the right button of a computer mouse is clicked while pointing to a screen name associated with a prospective member 702b. ... the invitation includes a hyperlink to facilitate joining the group, a personal welcoming message, and/or a list of current group members. When the hyper-link contained in the invitation is clicked, the prospective member 720b sends an affirmative confirmation message indicating the prospective member's desire to join the group and links to the group web site." (§0080-0085).

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-5 and 7-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Tornabene et al U.S. PUB. No. (20020023132).

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As claims 1,8-10, Tornabene et al teach a shared information processing system (fig. 1 and abstract) comprising

a client including highlighted file registration means for accepting from a user a request for registration of a highlighted file (automatically updated services provided to current members of the group (registered subscribers) include, providing a private group website, a list of current group members, a shared buddy list, shared member profiles, a private on-line forum for group members to chat with one another, a shared list of favorite sites, a shared photo gallery, and/or any other type of shared data files (§ 0084 and § 0091. See also § 0057-0058 and § 0030 and 0070) and performing registration of only a file name on a highlighted file list (selecting screen name of member to be invited to register for alerts by using mouse clicking § 0080-0085), and also notifying said server of registration information for said highlighted file § 0059-0060 and § 0080-0085);

highlighted file management means for acquiring information pertaining to said highlighted file through said server and managing the same (§ 0059-0062 and § 0080-0085); and

highlighted file status display means for displaying information pertaining to said highlighted file (A list of current group members may be displayed on the website or

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accessed by a hyperlink. The list also may indicate the online status of each group member ¶ 0080-0085); and

said server comprising highlighted file table management means for managing highlighted file names registered to said each client using registration information about which notification has been given by the highlighted file registration means of said client (¶ 0059-0062 and ¶ 0080-0085 and ¶ 0091); and

highlighted file information notification means for acquiring information pertaining to a highlighted file managed by the highlighted file table management means (subscriber's profile data include, subscriber's buddy list, alert preferences requested by the subscriber, designated stocks and identified interests, ¶ 0063-0064 and ¶ 0080-0086); and

giving notification thereof to the client where the highlighted file is registered (alerts and notification messages and are sent to group members displayed on the list ¶ 0059-0064 , ¶ 0077 and ¶ 0083. see also ¶ 0096);

wherein highlighted file names indicate locations where the files are stored (hyperlinks and home pages indicate the location where files/documents are store ¶ 0078-0082 ¶ 0084-0087 and 0091), and wherein a plurality of users (chat group members/users ¶ 0030 and 0058) can communicate simultaneously by

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the sharing channel set up on a network by a server and clients interconnected over said network (figs 2-3, login server 470 may implement one or more authorization procedures to enable simultaneous access to the OSP host complex 480 and the IM host complex 490, ¶ 0046 and 0056. See fig. 2 and 4), and notify other clients of a chat character string inputted by a user through a client (alerts and notification messages and are sent to group members ¶ 0059-0064, ¶ 0077 and ¶ 0083).

As claim 2, Tornabene et al teach the shared information processing system according to claim 1, wherein said highlighted file information notification means acquires basic information such as where said highlighted file is stored ¶ 0063-0064 and ¶ 0091-0092), and notifies said client thereof (¶ 0059-0064, ¶ 0077 and ¶ 0083. see also ¶ 0096).

As claim 3, Tornabene et al teach the shared information processing system according to claim 1, wherein said highlighted file information notification means acquires update information such as when and by whom said highlighted file was updated, and notifies said client thereof (¶ 0059-0064, ¶ 0077 and ¶ 0083-0084. see also ¶ 0096).



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As claim 4, Tornabene et al teach the shared information processing system according to claim 1, wherein said server further comprises user information management means for acquiring user information about a user that has registered said highlighted file at said client, and notifies the administrator of said highlighted file of statistical information based on said user information (§ 0063-0064 and § 0072).

As claim 5, Tornabene et al teach a shared information processing system comprising:

a server including highlighted file table management means for managing for managing highlighted file names registered to said each client using registration information about which notification has been given by the highlighted file registration means of said client (§ 0059-0062; § 0063-0064 and § 0080-0086 and § 0091) and for managing the correspondence between a channel and a highlighted file related to that channel (§ 0047-0048 and § 0057-0059); and

update information notification means for acquiring update information for said channel and updating information pertaining to the corresponding highlighted file, acquiring update information for said highlighted file and updating information pertaining to the corresponding channel , and notifying each

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client of the update information (subscriber's profile data include, subscriber's buddy list, alert preferences requested by the subscriber, designated stocks, identified interests, and geographic location. ¶ 0063-0064 and ¶ 0080-0086); and

said client comprising highlighted file management means for acquiring information pertaining to a highlighted file related to said channel through the server and managing the same (¶ 0059-0062 and ¶ 0080-0085 and ¶ 0091-0096); and

highlighted file status display means for displaying information pertaining to said highlighted file (A list of current group members may be displayed on the website or accessed by a hyperlink. The list also may indicate the online status of each group member ¶ 0078 and ¶ 0080-0085),

wherein highlighted file names indicate locations where the files are stored (hyperlinks and home pages indicate the location where files/documents are store ¶ 0078-0082 ¶ 0084-0087 and 0091), and wherein a plurality of users (chat group members/users ¶ 0030 and 0058) can communicate simultaneously by the sharing channel set up on a network by a server and clients interconnected over said network (figs 2-3, login server 470 may implement one or more authorization procedures to enable simultaneous access to the OSP host complex 480 and the IM host complex 490, ¶ 0046 and 0056. See fig. 2 and 4), and notify

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other clients of a chat character string inputted by a user through a client (alerts and notification messages and are sent to group members ¶ 0059-0064, ¶ 0077 and ¶ 0083).

As claim 7, Tornabene et al teach the shared information processing system wherein a plurality of users can communicate simultaneously by the sharing of one of virtual chat rooms (hereinafter "channel") set up on a network by a server and clients interconnected over said network, and the notifying of other clients of a chat character string inputted by a user through one said client, said client comprising highlighted file name extraction means for extracting file names that can be registered as highlighted files from a chat character string inputted by a user within a channel (¶ 0048 and , ¶ 0070. See also ¶ 0059-0064, ¶ 0077 and ¶ 0083);

highlighted file registration determination means for determining whether or not a file corresponding to an extracted file name is to be registered as a highlighted file (¶ 0048 and ¶ 0070. See also ¶ 0059-0064, ¶ 0077 and ¶ 0083);

highlighted file registration means for registering a highlighted file as related to a corresponding virtual chat room when the highlighted file registration determination means determines that a highlighted file is to be registered, and

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notifying said server of registration information for said highlighted file (automatically updated services provided to current members of the group (registered subscribers) include, providing a private group website, a list of current group members, a shared buddy list, shared member profiles, a private on-line forum for group members to chat with one another, a shared list of favorite sites, a shared photo gallery, and/or any other type of shared data files (§ 0084 and § 0091. See also § 0057-0058 and § 0030 and 0070);

highlighted file management means for acquiring information pertaining to said highlighted file through said server and managing the same (§ 0059-0062 and § 0080-0085); and

highlighted file status display means for displaying information pertaining to said highlighted file; and

said server including highlighted file table management means for managing highlighted file names registered to said client using the registration information about which notification has been given by the highlighted file registration means of said client (§ 0078 and § 0080-0085); and

highlighted file information notification means for acquiring information pertaining to a highlighted file managed by said highlighted file table management means, and giving notification thereof to the channel or the client where said

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highlighted file is registered (§ 0057-0062 and § 0080-0085 and § 0091. See § 0047-0048),

wherein a plurality of users (chat group members/users § 0030 and 0058) can communicate simultaneously by the sharing channel set up on a network by a server and clients interconnected over said network (figs 2-3, login server 470 may implement one or more authorization procedures to enable simultaneous access to the OSP host complex 480 and the IM host complex 490, § 0046 and 0056. See fig. 2 and 4), and notify other clients of a chat character string inputted by a user through a client (alerts and notification messages and are sent to group members § 0059-0064, § 0077 and § 0083).

As per claims 11-14, these claims have similar limitations as

As per claims 11-14, these claims include similar limitations as 1, 5 and 7, therefore, they are rejected with the same rationale. See claims 1, 5 and 7.

***Allowable Subject Matter***

5. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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### Conclusion

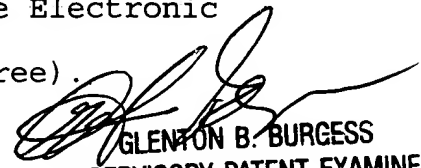
6. The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Bargadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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